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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,498	11/05/1999	MUNEHIRO DATE	ASAIN0058	4034

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EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/02/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/434,498

Applicant(s)

Date et al.

Examiner

Bruce Hess

Group Art Unit

1274

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 8-21-01 (IDS) and 10-1-01 (Petition and Amendment)

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 and 3-7 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Claims 1 and 3-7 are rejected under 35 USC 112 (first paragraph) as being based upon a non-enabling disclosure.

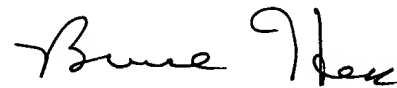
Absent a disclosure of what materials are employed in order to attain the functional parameters (e.g., heat the heat sensitive layer to a molten state and quickly cool to a solid colored state followed by heating the heat sensitive layer to a color-erasing temperature lower than the melting temperature of the heat sensitive layer) claimed, one of ordinary skill in this art could not make and use the claimed invention. The only materials specifically disclosed are seven types of conventional color developers which can be employed without any restriction with any and all dyestuff precursors (see page 8, lines 8-21). It is submitted that as known color developers, these seven developers have routinely been employed with conventional color formers. Absent any other disclosed materials (e.g., binders or processing additives), one of ordinary skill in this art can only assume that the aforementioned claimed functional parameters are inherent in any and all prior art compositions that contain any of the seven disclosed color developers and any known color former. This unlikely scenario serves as the basis for the art rejection which follows. The more likely scenario is that applicants actually employ particular binders and processing additives which enable their claimed functional parameters to be attained. Absent the identification of these materials, applicants' disclosure is non-enabling.

2. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' statement of the prior.

As noted above, the prior art combination of any one of seven known color developers with a conventional color former would have been an obvious expedient to one of ordinary skill

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in this art. “[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” In re Swinehart et al., 169 USPQ 226 at 229. The burden is upon “applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on”. In re Swinhart et al., supra.

A handwritten signature in black ink, appearing to read "Bruce H. Hess". The signature is fluid and cursive, with the first name "Bruce" and last name "Hess" clearly distinguishable.

BRUCE H. HESS  
PRIMARY EXAMINER